



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,887	04/16/2001	Paola Lenti	1011-287	4551

7590 10/24/2002

James V. Costigan, Esq.
HEDMAN & COSTIGAN, P.C.
Suite 2003
1185 Avenue of the Americas
New York, NY 10036-2646

EXAMINER

PIERCE, JEREMY R

ART UNIT	PAPER NUMBER
----------	--------------

1771

DATE MAILED: 10/24/2002

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/835,887

Applicant(s)

LENTI, PAOLA

Examiner

Jeremy R. Pierce

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The use of the trademark VELCRO has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites a "closed cell high density modified foamed polyethylene layer." The term "high" is a relative term. What is the density high compared to? The term "high" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 5 recites a "bi-adhesive strip on the face thereof opposite to the face thereof coupled to said bottom layer." First, what does the term "bi-adhesive" mean?

Application/Control Number: 09/835,887
Art Unit: 1771

The Examiner cannot see a difference between bi-adhesive and adhesive. Second, the claim is confusing because it seems to desire the "bi-adhesive" to be attached on top of the tearable strip (indicated to be Velcro in the specification). Wouldn't this render the tearable strip layer meaningless because it would no longer perform its desired function? The Applicant does not offer any other material besides Velcro that may comprise the tearable strip in the specification. The Examiner will assume the "bi-adhesive" strip would comprise the mating portion of the Velcro material with an adhesive provided on its backside facing away from the composite.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4, 6, 8, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Latzke (U.S. Patent No. 4,887,368).

Latzke teaches a composite material comprising an outer layer of woven wool (column 7, lines 42-46), a central layer of closed-porous polyethylene foam (column 8, lines 4-9), and a bottom layer to which a Velcro strip fastener may be attached (column 4, line 35). The claimed bottom layer can be anticipated by many embodiments, such as the additional foam layer or the backing material that would be present on the Velcro. Since Latzke does not disclose the Velcro attached to the bottom layer must be male or

female, one can assume that either can be attached. With regard to claim 3, Latzke teach the density of the foam can be adjusted to include high density foam (column 5, lines 37-50). With regard to claim 4, the surface of the Velcro material would not slip when attached to a corresponding Velcro strip. With regard to claim 6, Latzke teach flame bonding in addition to using hot-melt adhesive to couple the layers (column 11, lines 47-52). With regard to claim 8, Latzke discloses the material may be used to insulate floors, walls, and roofs (column 4, lines 59-62).

6. Claims 1-5 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Berry (U.S. Patent No. 4,350,726).

Berry discloses a pad comprising a fleece layer and a foam layer (column 3, lines 20-35). The fleece layer can be a natural or synthetic wool coat with a woven backing, and the foam layer can be closed cell polyethylene. Velcro tape is attached to the foam layer opposite the side of the fleece layer (column 4, lines 9-14). The backing layer of the Velcro tape would comprise Applicant's bottom layer of a material suitable for coupling with a male portion of a tearing strip. Since Berry does not disclose the Velcro attached to the foam must be male or female, one can assume that either can be attached to the foam. With regard to claim 3, Applicant does not address how high the density of the foam needs to be to achieve "high density" status. With regard to claim 4, Berry teaches the Velcro keeps the pad in the desired position (column 4, lines 13-14). With regard to claim 5, the mating portion of the Velcro strips can attached anywhere with an adhesive layer (column 4, lines 16-20). When the male and female Velcro strips

Art Unit: 1771

are attached, a further layer of adhesive would be attached to the tearable strip on the face opposite of the bottom layer.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Latzke.

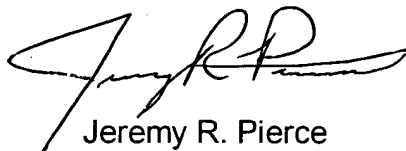
With regard to claim 5, Latzke discloses a self-adhesive layer can be used to attach the composite to the desired surface (column 2, lines 21-24). It would have been obvious to one having ordinary skill in the art to provide adhesive onto the tearable strip in order to create a permanent bond between composite and the surface to which the composite is being attached. With regard to claim 7, Latzke discloses the material may be formed into any desired shape (Abstract), but do not disclose using a contoured mold to cut the composite into the desired shape. It would have been obvious to one having ordinary skill in the art to cut the composite to the desired shape by using a contoured mold in order to create many composites with the same shape in a fast process.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (703) 605-4243. The examiner can normally be reached on Monday-Thursday 7-4:30 and alternate Fridays 7-4.

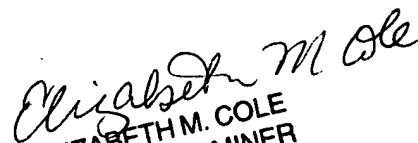
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Jeremy R. Pierce
Examiner
Art Unit 1771

October 21, 2002



ELIZABETH M. COLE
PRIMARY EXAMINER